

REMARKS

Claims 93-102 and 104-121 are pending. Applicants respectfully request that the Examiner reconsider all rejections in the outstanding Office Action in view of the foregoing amendments and the following remarks.

1. 35 U.S.C. § 102(b)

Claims 93-100, 102, and 104 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 5,436,640 to Reeves. Office Action, page 2. Applicants traverse the instant rejection on the following grounds.

To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131.

Applicants submit that Reeves fails to teach every element of the claimed invention. Particularly, amended independent claim 93 recites the following.

93. An input device for generating signals that represent input requests by a user, said device comprising:
a base portion having a top surface;
four primary keys disposed on said top surface;
at least one position-responsive input value selector that is responsive to a position of the top surface within a substantially horizontal plane;
a signal generator operatively connected to the primary keys and the position-responsive selector generating a first signal indicating a user input value selection and a second signal indicating user data input request; and
an input selection mechanism for permitting a user to operate said input device in a character selection mode or a cursor movement mode. (Emphasis added).

Accordingly, claim 93 includes an input selection mechanism for permitting the user to operate the input device in a character selection mode or a cursor movement mode. Support for this feature is found at least at page 22, lines 8 to 25. Reeves teaches a joystick controller for use in a video simulation system. *See* Reeves, abstract. Reeves fails to teach operating the joystick controller in a plurality of modes, such as a character selection mode or a cursor movement mode, nor an input selection mechanism for permitting a user to operate between a plurality of modes. Applicants respectfully submit that claim 93 is not anticipated nor rendered obvious as Reeves, either taken alone or in combination with any other cited references, does not disclose or suggest at least “an input selection mechanism for permitting a user to operate said input device

in a character selection mode or a cursor movement mode” as claimed. Claims 94-100, 102, and 104 depend from claim 93 and are therefore patentable for at least this reason.

Dependent claim 99 further recites “a second input device adapted for the other hand of the user.” Applicants submit that Reeves clearly does not teach at least this feature. In fact, Reeves teaches the use of one joystick and makes no reference to the use two joysticks, one of which is adapted for the other hand of the user. Thus, claim 99 is not anticipated by Reeves for yet another reason.

Dependent claim 100 further recites “wherein said base portion is movable on the surface upon which it is placed and said changes in position are of the entire base portion relative to its position prior to moving.” Applicants submit that Reeves clearly does not teach this feature. Reeves teaches a joystick 20 comprising a handle 22 and a base 28. Reeves, col. 4, ll. 17-20. The handle 22 is moved relative to the base 28. *Id.* at col. 4, ll. 24-30. Reeves fails to teach that the base 28 is movable on a surface upon which it is placed as claimed. Thus, claim 100 is not anticipated by Reeves for yet another reason.

Applicants submit that the instant rejection is unsustainable and respectfully request the Examiner to withdraw the rejection of claims 93-100, 102, and 104.

2. 35 U.S.C. § 103(a)

Claim 101 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Reeves in view of U.S. Patent No. 5,436,640 to Ishiwata *et al.* (“Ishiwata”). Office Action, page 8. Particularly, the Office Action asserts that Reeves fails to disclose a mouse mechanism as an input value selector. *Id.* at page 10. In order to cure such a deficiency, the Office Action contends that it is well known in the art to use a mouse as an input device and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated a mouse as the input device for the input value selector.¹ *Id.* at page 11. Applicants respectfully disagree and traverse this rejection on the following grounds.

In order to establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143 (citations omitted). In order to support a § 103 rejection, the Examiner must provide a sufficient motivation for making the proposed combination of references or modification to a single

¹ No reference is made to Ishiwata in the grounds of this rejection.

reference. *See* M.P.E.P. §§ 2142 and 2143.01. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The Examiner fails to present a convincing line of reasoning as to why it would have been obvious to modify Reeves’ joystick in such a way as to include a mouse mechanism. The Office contention that “it was obvious . . . to have incorporated the mouse as the input device for the input value selector” is a broad, conclusory statement and is not the convincing line of reasoning under the controlling authorities set forth above, to justify such a modification. Moreover, there is no showing that either of the applied references, or any other prior art, even remotely suggests such a modification. Applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness.

In addition, the proposed modification would change the principle of operation of the Reeves’ joystick. Reeves’ joystick is intended for use with video games, particularly flight simulators. Reeves, col. 1, ll. 33-42. The joystick is configured in such a way so that a user’s fingers are wrapped around the shaft 24 and a user’s thumb is positioned on the top end to operate switch 32. Replacing such with a mouse would completely destroy the principle operation of this device. If the proposed modification would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Claim 101 also depends from independent claim 93, which is submitted to be novel and non-obvious in view of the cited references as remarked above.

Applicants submit that the instant rejection is unsustainable and respectfully request the Examiner to withdraw the rejection of claim 101.

3. New Claims

Applicants respectfully submit that newly added claims 105-121 are patentable over the cited art.

Independent claim 105 recites the following.

105. An input device for generating signals that represent input requests by a user, said device comprising:

- a base portion having a top surface;
- four primary keys disposed on said top surface, wherein said four primary keys are located in a substantially horizontal plane;
- at least one position-responsive input value selector that is responsive to a position of the top surface within a substantially horizontal plane; and
- a signal generator operatively connected to the primary keys and the position-responsive selector generating a first signal indicating a user input value selection and a second signal indicating user data input request. (Emphasis added).

Claim 105 includes, *inter alia*, four primary keys located in a substantially horizontal plane. Support for this limitation is found at least in Figs. 11 and 17, and throughout the specification. Reeves, either taken alone or in combination with the secondary references, fails to disclose or suggest at least this limitation. Therefore, claim 105 is patentable over the cited art.

Independent claim 116 recites the following.

116. A computer system comprising:
at least one input device comprising:

- a base portion having a top surface;
- four primary keys disposed on said top surface;
- at least one position-responsive input value selector that is responsive to a position of the top surface within a substantially horizontal plane;

and

- a signal generator operatively connected to the primary keys and the position-responsive selector generating a first signal indicating a user input value selection and a second signal indicating user data input request;
- a processor operatively connected to said signal generator for receiving and processing said first and second signals;
- a display operatively connected to the processor; and
- a character selection graphic displayed on the display, the character selection graphic comprising a plurality of character selection icons, each of the icons corresponding to a character, wherein the character selection icons are selected by moving or positioning the top surface relative to the base portion and selectively engaging one of the four primary keys. (Emphasis added).

Claim 116 includes, *inter alia*, a character selection graphic displayed on a display, the character selection graphic comprising a plurality of character selection icons, each of the icons corresponding to a character, wherein the character selection icons are selected by moving or positioning the top surface relative to the base portion and selectively engaging one of the four primary keys. Support for this limitation is found at least in Figs. 7 and 21, and throughout the specification. Reeves merely teaches a joystick for use in a video game and no quasi-keyboard

operation features are disclosed or suggested. Reeves, either taken alone or in combination with the secondary references, fails to disclose or suggest at least this limitation. Therefore, claim 116 is patentable over the cited art.

Applicants submit that claims 106-115 and 117-121 are patentable at least because they depend from one of novel and non-obvious independent claims 105 and 116.


CONCLUSION

Applicants respectfully submit that this application is in condition for allowance, and such disposition is earnestly solicited. Applicants submit herewith a Request for Three-Month Extension of Time and the requisite fee. No additional fee is believed to be required. Nevertheless, in the event that the U.S. Patent and Trademark Office requires a fee to enter this Response or to maintain the present application as pending, please charge such fee to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,
HUNTON & WILLIAMS

Dated: May 13, 2003

By:


Rodger L. Tate
Registration No. 27,399

Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W., Suite 1200
Washington, DC 20006-1109
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)

RLT/TC/cdh